

The March 10, 2006 Final Office Action, for the first time, rejects claims 20-23 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. That rejection is moot because claims 20-23 are canceled. New claims 47-49 recite a "machine readable physical storage medium." (Emphasis added). To the extent the Office would make the same Section 101 rejection to the new claims 47-49, the rejection is obviated.

10/25/06
JES
PREMATURE FINALITY OF OFFICE ACTION

Applicants respectfully traverse the "final" designation of the Final Office Action and request that it be removed. The Final Office Action contains a new ground of rejection – the rejection of claims 20-23 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The Office Action should not therefore be final. "Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is [not] necessitated by applicant's amendment of the claims" MPEP § 706.07(a). Amendments to the claims could not have necessitated this new ground of rejection because rejected claims 20-23 were in their original form.

On June 28, 2006, Michelle Evans, legal assistant to patent attorney Paul A. Mendonsa, spoke by telephone with the Examiner requesting that the finality of the rejection be removed because of the above new ground of rejection. The Examiner would not agree to remove the finality of the rejection without the finality being traversed in a response. The Examiner suggested submitting an amendment and if the amendment overcame the new rejection, the finality would be removed.

Applicants assert that new claims 47-49 are not subject to the above new ground of rejection. However, regardless, Applicants respectfully request that the finality designation be removed in compliance with MPEP § 706.07(a).